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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,475	04/20/2006	Sebastian Bach	2003DE117	5841
25255	7590	01/10/2007	EXAMINER	
CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205			CHEUNG, WILLIAM K	
			ART UNIT	PAPER NUMBER
			1713	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	01/10/2007		PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/533,475	BACH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William K. Cheung	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 June 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 061206, 100705.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1, 10, 11 are objected to because of the following informalities: Although claims 1, 10, 11 are not identical word for word, claims 1, 10, 11 are claiming identical scope of invention. Therefore, claims 10 and 11 are redundant. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-5, 7-13 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hohner (US 5,998,547).

*The invention of claims 1-9, 12, 13 relates to a hotmelt adhesive comprising between 0.1 and 100% by weight of at least one polyolefin wax prepared using a metallocene catalyst and having a dropping point or ring & ball softening point of between 80 and 165°C and a melt viscosity, measured at a temperature 10°C above the dropping or softening point, of not more than 40 000 mPa.s.*

*The invention of claim 10 relates to a hotmelt adhesive containing between 0.1 and 100% by weight of polyolefin waxes prepared using metallocene catalysts and having a dropping point or ring & ball softening point of between 80 and 165°C and a melt viscosity, measured at a temperature 10°C above the dropping or softening point, of not more than 40 000 mPa.s.*

*The invention of claim 11 relates to a hotmelt adhesive comprising between 0.1 and 100% by weight of a polyolefin wax prepared using a metallocene catalyst and having a dropping point or ring & ball softening point of between 80 and 165°C and a melt viscosity, measured at a temperature 10°C above the dropping or softening point, of not more than 40 000 mPa.s.*

Hohner (col. 2, line 28-51) discloses composition comprising polyolefin waxes prepared using metallocene catalysts having the dropping point or ring & ball softening point and the melt viscosity properties that significantly overlap the dropping point or ring & ball softening point and the melt viscosity properties as claimed. Hohner (col. 8, claims 13-16) clearly claimed that disclosed composition as adhesives. In view of substantially identical material compositions, and dropping point or ring & ball softening point of between 80 and 165°C properties, the examiner has a reasonable basis to believe that the claimed "measured at a temperature 10°C above the dropping or softening point" and the molecular weight properties are inherently possessed in Hohner. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as obvious over Hohner (US 5,998,547).

Hohner (col. 2, line 28-51) discloses composition comprising polyolefin waxes prepared using metallocene catalysts having the dropping point or ring & ball softening point and the melt viscosity properties that significantly overlap the dropping point or ring & ball softening point and the melt viscosity properties as claimed. Hohner (col. 8, claims 13-16) clearly claimed that disclosed composition as adhesives. In view of substantially identical material compositions, and dropping point or ring & ball softening point of between 80 and 165°C properties, the examiner has a reasonable basis to believe that the claimed "measured at a temperature 10°C above the dropping or softening point" and the molecular weight properties are inherently possessed in Hohner. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

The difference between claim 6 and Hohner is that Hohner does not disclose an adhesive composition comprising a homopolyethylene.

However, Hohner (col. 1, line 13, 50) in the background teaches the suitability of homopolyethylene waxes in adhesive application. In view of substantial identical endeavors in the development of adhesives based on polyolefins between the teachings of Hohner and the background teachings, it would have been obvious to one of ordinary skill in art to incorporate the homopolyethylene background teachings to incorporate

to the taught composition of Hohner as an viscosity modifier additive to obtain the invention of claim 6.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William K. Cheung, Ph. D.

Primary Examiner

January 7, 2007

WILLIAM K. CHEUNG  
PRIMARY EXAMINER